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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/340,283 06/25/99 MESSING

R GALO-007/01U

PATENT GROUP  
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HM22/1216

EXAMINER

SHUKLA, R

ART UNIT

PAPER NUMBER

1632

DATE MAILED:

12/16/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/340,283

Applicant(s)

Messing et al

Examiner

Ram Shukla

Group Art Unit

1632



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-28 \_\_\_\_\_ is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-28 \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152.

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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#### **DETAILED ACTION**

1. Claims 1-28 are pending in the instant application.

#### **RESTRICTION/ELECTION**

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-9, drawn to transgenic animals containing a mutation in PKC isozyme, classified in class 800, subclass 8.
  - II. Claim 10, drawn to a method of screening for compounds that modify anxiety, classified in class 424, subclass 9.1.
  - IV. Claims 11-21, drawn to a method of treatment using PKC modulators, classified in class 514, subclass 1.
  - V. Claim 22, drawn to a method of screening for drug dependence, classified in class 424, subclass 9.1.
  - VI. Claims 23-28, drawn to a composition of PKC inhibitors and agonists, classified in class 515, subclass 1.

3. The inventions are distinct, each from the other because of the following reasons:

The invention of the group I is drawn to a transgenic animal and cells expressing a mutant PKC isozyme and is patentably distinct from the inventions of each of the groups II-VI because the methods of groups II-V as well as the composition of group VI can not be used to make the transgenic animal of group I and because there are multiple uses of the transgenic animal of group I, for example it can be used to produce mutant protein or it can be used as a disease model. The inventions of the groups II-V are drawn to a method of identifying compounds that modify anxiety, a method of treatment using PKC modulators and a method for identifying drug dependence, respectively. The methods of the groups II-V are patentably distinct each from the other because the steps involved in each method would be different. Furthermore, the components required for practicing the methods, for example, compounds being screened or subjects being tested would have different characteristics. Additionally, the invention of the group VI is patentably distinct from each of the methods of the group II-V and the transgenic animal of group I because the methods of the groups II-V can not be used for making the compositions of group VI. Additionally, the composition of group VI may be used in different

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methods and therefore would have multiple utilities. For example, the composition of group VI can be used in in vitro studies using purified PKC enzyme or in cells in culture or in animals. In conclusion, the inventions of the groups I-VI are patentably distinct each from the other and their analysis will require separate searches in the non-patent literature.

4. Because these inventions are distinct for the reasons given above, have acquired a separate status in the art shown by their different classification and their recognized divergent subject matter, and because each invention requires a separate, non-coextensive search, restriction for examination purposes as indicated is proper.

5. A telephone call was made to Ms. Maraya Postner on 11-2-99 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ram R. Shukla whose telephone number is (703) 305-1677. The examiner can normally be reached on Monday through Thursday and every other Friday from 8:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jasmine Chambers, can be reached on (703) 308-2035. The fax phone number for this Group is (703) 308-4242.

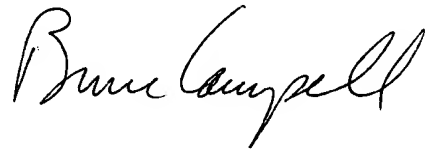
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-0196.

Ram R. Shukla, Ph.D.



Ram R. Shukla, Ph.D.

BRUCE R. CAMPELL  
PRIMARY EXAMINER  
GROUP 1800